

REMARKS

Applicants wish to express their gratitude to the Examiner for granting a personal interview on May 16, 2006 to discuss the remaining issues in the case.

The specification has been amended to reflect the fact that the parent application of this divisional is U.S. Serial No. 08/855,499, filed May 13, 1997, which has issued as U.S. Patent No. 6,271,278. The specification is also amended to reflect the fact that patent '278 is a continuation-in-part of U.S. Serial No. 08/416,269, filed April 4, 1995, now U.S. Patent No. 5,750,585. Patent '278 is the subject of Reissue application No. 10/807,227, filed March 22, 2004. The references to related applications appearing in the currently amended paragraph reflect those made in the co-pending reissue application. The original paragraph was submitted in a Preliminary Amendment dated March 13, 2001.

Claims 56-73 are pending in this application. Claims 64-73 have been withdrawn. Claim 56 has been amended to claim a hydrogel foam formed by the recited method in which the blowing agent is an inorganic carbonate, support for which is found at page 18, line 11. Reexamination and reconsideration are respectfully requested.

I. Claims 56-63 were rejected under 35 USC 102(a) as being anticipated by Hahnle et al. (DE 195 40 951, corresponding to US Patent 6,136,873).

The Action does not indicate the effective date of Hahnle et al.; however, applicants presume it is the "Offenlegungstag": May 7, 1997. As mentioned above, the filing date of parent application USSN 08/855,499 is May 13, 1997. However, the claimed subject matter was invented in the United States prior to the effective date of Hahnle et al. This is evident from the attached Rule 131 Declarations of inventors Kinam Park and Haesun Park. The Declarations refer to the attached Statement of James H. Meadows, the undersigned attorney, and establish that the invention was conceived and reduced to practice well in advance of the filing date of the parent application, and prior to the presumed effective date of Hahnle et al.

Moreover, Hahnle et al. do not teach or suggest use of an inorganic carbonate as a blowing agent in preparing their polymer foam. (see, e.g., col. 10, lines 1-54 of Patent '873) Additionally, the amended specification paragraph presented hereinabove clearly shows that the claimed subject matter is entitled to a date prior to the effective date of Hahnle et al.

For the foregoing reasons, Hahnle et al. is not properly cited as a reference under 35 USC 102(a).

II. Claims 56-63 were rejected under 35 USC 102(b) as being anticipated by Van Phan et al. (US Patent 5,506,035).

Van Phan et al. disclose an absorbent polymer foam for use in diapers, sanitary napkins, and the like. The Action maintains that the materials employed by Van Phan et al. and the process by which the foams are made are so similar to the instant materials and processes that formation of the porous polymer network of the claimed invention is deemed to be inherent to the teachings of the cited reference.

A hydrogel foam of the claimed invention is formed by the recited method, which entails use of a "inorganic carbonate" blowing agent. Representative of such blowing agents are sodium carbonate, sodium bicarbonate, and calcium carbonate. (page 18, lines 1-13) In contrast, a blowing agent contemplated by van Phan et al. is a low boiling point liquid, which becomes a gas upon being heated. (See, Example 1 and col. 11, lines 7-43) The cited reference does not teach or suggest use of any solid substance, such as an inorganic carbonate, to make the polymer foam. Hence, Van Phan et al. are not properly cited as anticipating the claimed product-by-process.

In addition, as is evident from the amended specification paragraph presented hereinabove, the date to which the claimed subject matter is entitled, i.e., April 4, 1995, precedes the

patent date of the cited reference, i.e., April 9, 1996. It should also be noted that the filing date to which the claimed subject matter is entitled is within one year following the patent date of the parent application of the cited reference, i.e., August 16, 1994 (for U.S. Patent No. 5,338,766).

For the foregoing reasons, Van Phan et al. is not properly cited as a reference under 35 USC 102(b).

III. Claims 56-63 were rejected under 35 USC 102(b) as being anticipated by Park et al. (Society of Biomaterials article).

Park et al. is cited as disclosing the claimed hydrogel foams. The Action maintains that the recited properties of the claimed hydrogel foam are inherently possessed by the materials of Park et al. However, no record is established that the cited article "necessarily and inevitably" produces a hydrogel foam having the recited properties.

Still, the publication date of Park et al. is April 5-9, 1994. However, as is reflected in the amended specification paragraph presented hereinabove, the filing date to which the present application is entitled is April 4, 1995, which is the filing date of the application culminating in U.S. Patent No. 5,750,585. Support for the claimed product-by-process is found

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at least in Examples 2-7 of Patent '585. Hence, any basis for this rejection is overcome.

IV. Claims 56-63 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of US Patent 5,750,585.

Any basis for this rejection is overcome by the Terminal Disclaimer filed herewith, which is signed by the undersigned attorney of record. The Terminal Disclaimer disclaims the terminal part of the statutory term of any patent granted on the instant application which exceeds the expiration date of the full statutory term of US Patent 5,750,585. The requisite fee accompanies.

IV. Claims 56-63 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of US Patent 6,960,617.

Any basis for this rejection is overcome by the Terminal Disclaimer filed herewith, which is signed by the undersigned attorney of record. The Terminal Disclaimer disclaims the terminal part of the statutory term of any patent granted on the instant application which exceeds the expiration date of the full statutory term of US Patent 6,960,617. The requisite fee accompanies.


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In view of the foregoing amendments and remarks, it is evident that the application is in condition for allowance. A Notice of Allowability is solicited.

Finally, the Examiner is urged to consider the reference furnished with the accompanying Information Disclosure Statement and Form 1449, and to list that reference among the "References Cited" on any patent to issue on this application.

If, in the opinion of the Examiner, a telephone conversation could expedite prosecution, the Examiner is invited to telephone the undersigned attorney at the number given below.

Respectfully submitted,


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Attachments

CERTIFICATE OF MAILING

I, James H. Meadows, hereby certify that this paper is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date August 8, 2006 Signature: 